

CH

**UNITED STATES PATENT AND TRADEMARK OFFICE**

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,606	04/26/2001	Bradley A. Bloechel	10559-400001 / P10337	7665

20985 7590 08/27/2003

FISH & RICHARDSON, PC
4350 LA JOLLA VILLAGE DRIVE
SUITE 500
SAN DIEGO, CA 92122

EXAMINER

NGUYEN, JIMMY

ART UNIT	PAPER NUMBER
----------	--------------

2829

DATE MAILED: 08/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/843,606

Applicant(s)

BLOECHEL, BRADLEY A.

Examin r

Jimmy Nguyen

Art Unit

2829

-- The MAILING DATE of this communication appears on the cover sheet with th correspondence address --

Period f r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7 -15 is/are allowed.
- 6) ☒ Claim(s) 1 - 6, 16 -18 is/are rejected.
- 7) ☒ Claim(s) 19 -27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Argument

1. Applicant's arguments with respect to claims 1-6 and 16-18 have been carefully considered with the following remark;

The applicant argues that Motoi (US 6480016) fail to disclose the bold features **“evaluating the DUT based on a comparison of the response signals from the DUT with the stored event signals received from the holding circuit”**.

The examiner is disagree. The tester body (101) generates the same signal for both storage 106a and 106b as seen in figure 1, the signals applied to the storage 106a and 106b are identical. Further, the response signal from the dut (103) is comparing the signal with the signal from storage circuit 106b (which is identical with storage 106a) and therefore it is comparing the response signal from the dut (103) with stored event signal.

Thus, the amendments do not render the claims distinct and patentable over prior art, nor they overcome the rejection. The applicant's arguments have been considered in full, but they are not persuasive. Therefore, this office action is made final.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1 – 6, 16 – 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Motoi et al (US 6480016).

As to claims 1, 16, Motoi et al disclose (fig 1) a method and the system

Generating event signals (101);

Storing the event signals (104) in a holding circuit (105a);

Producing response signals (output from 103) in a dut (103) in response to the event signals (104); and

A measuring device (101) for evaluating the dut (103) based on the response signals from the dut (103) and stored event signals from the holding circuit.

As to claims 2, 17, Motoi et al disclose

Generating trigger signals (by the tester 101) ; and

Synchronizing each trigger signal with an event signal (104) such that the trigger signal occurs between a rising edge of the event signal and a falling edge of the event signal

As to claims 3, 4, 18, Motoi et al disclose (fig 1) continuing to store an initial state of each event signal (104) in the holding circuit (105a) after transition of the

event signal to a subsequent state (startup testing) and applying a reset signal to the holding circuit (105a)

As to claims 5, 6, Motoi et al disclose the event signal (104) is able to generate plural programs (from tester 101)

Allowable Subject Matter

2. Claims 7 – 15 are allowed.

The prior art of record fails to disclose

A first input port for receiving a trigger signal coupled to the input of the driving circuit

A second input port for receiving an event signal coupled to the first end of the first conductor;

An output port for outputting a hold signal coupled to the second end of the first conductor; and

A second conductor having an impedance higher than an impedance of the first conductor, and coupled between the output of the driving circuit and a connection point on the first conductor.

3. Claims 19 –27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art of record fails to disclose

Art Unit: 2829

A first input port for receiving a trigger signal coupled to the input of the driving circuit

A second input port for receiving an event signal coupled to the first end of the first conductor;

An output port for outputting a hold signal coupled to the second end of the first conductor; and

A second conductor having an impedance higher than an impedance of the first conductor, and coupled between the output of the driving circuit and a connection point on the first conductor.

Conclusion

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

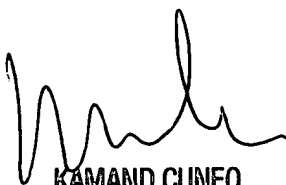
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

Art Unit: 2829

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy Nguyen at (703) 306-5858. Any inquiry of a general nature of relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4900.

JN.
August 12, 2003



KAMAND CUNEO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800